

REMARKS

Claims 1-22 are all the claims pending in the application.

I. Information Disclosure Statement

The Examiner stated that the information disclosure statement filed 10 December 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document.

The Applicant concurrently submits a new Information Disclosure Statement with a legible copy of the each cited foreign patent document, as per 37 CFR 1.98(a)(2), as well as the fee required under 37 CFR 1.97(c).

II. Specification

The Examiner first objected to the abstract of the disclosure because of implied phraseology and legal phraseology that should be corrected. The Applicant herein submits an amended abstract to remove the language mentioned by the Examiner.

The Examiner additionally objected to the disclosure because of several informalities. The Applicant has reviewed the entire disclosure and herein submits amendments to several sections to correct the informalities.

III. Claim Rejections: 35 USC §102(e)

The Examiner rejected claims 1-22 under 35 USC §102(e) as being anticipated by Mani (US 2002/0188725 A1) (hereinafter “Mani”). The Applicant respectfully disagrees.

To be anticipating, a prior art reference must disclose "each and every limitation of the claimed invention." In re Paulsen, 30 F.3d 1475, 1478-79, 9.d 1448, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

a. Claim 1

With regard to claim 1, the Applicant submits that Mani fails to disclose each and every element of claim 1, as Mani does not disclose the ability to "...enable said terminal (4) to set up a connection with said server (2) on the first channel *during a voice connection on said second channel*, so as to make at least some of said services offered by said second network (RP) available to said terminal *during said voice connection*." *Claim 1* (emphasis added).

The Examiner states that the element of sending configuration data to a terminal "during a voice connection on said second channel" is disclosed by the abstract and paragraphs [0026] and [0041] of Mani. Specifically, the Examiner argues that the abstract discloses an "access service application running," that paragraph [0026] discloses that the access service application includes voice recognition technology, and that paragraph [0041] discloses that the access service application could use audio or video capture from the terminal. However, the invention disclosed in Mani is completely different from that of the invention of claim 1, and the elements cited by the Examiner do not teach the invention described in claim 1.

To summarize one possible embodiment of the invention of claim 1, the invention teaches a server that allows a user of a phone to access services of the user's private communication network while the user is connected to another network and talking on the phone to another user. As stated in the Specification, "[t]he object of the invention is to enable mobile

telephones 4 to access dynamically services offered by their own private network RP when they are connected to one of the public networks, for example the PLMN.” *Specification*, p. 9, lines 8-10. Claim 1 therefore describes how the communication server makes services offered by a private communication network available to terminals connected to a first communication network by transmitting configuration data from the communication server to a terminal on the first channel *during a voice connection on said second channel*.

In contrast, Mani describes a “User Verification Service” that attempts to verify that a user is permitted to access a multimedia capable network by launching “interrogation procedures” to query the user and analyze the multimedia responses before permitting access to the network. Specifically, Mani states that the invention provides a “user verification scheme for use as a network-based service in a multimedia-capable network wherein access to controlled facilities such as, e.g., corporate or enterprise networks, home networks, physical locations (residential or commercial), access-controlled services and the like, is verified using multimedia response criteria.” *Mani*, paragraph [0007]. Therefore, Mani is concerned with providing a security access mechanism for *gaining access* to a network such as a secured *corporate or enterprise network*. Mani is not concerned with providing services to a telephone caller who is talking on the phone to another caller and wants to receive advanced network services at the same time, as is the purpose of the claimed invention. Mani does not discuss a voice call or connection with another user, as Mani has a completely different purpose that has nothing to do with establishing a voice connection between users. Mani is concerned only with communication between a user and a network that the user wishes to access. Communication

from one user to another user, such as that of the “voice connection” described in claim 1 is not disclosed at any point in Mani.

The Examiner cites to paragraph [0026] as mentioning the use of voice recognition technology, which the Examiner presumably equates with the “voice connection” described in claim 1. However, the “voice connection” of claim 1 is clearly defined in the Specification as a connection “dedicated to the *exchange* of voice data.” *Specification*, p. 11, line 13. In contrast, the voice recognition technology of Mani would only be used when the user communicates with the network access application to gain access to a network. The Examiner further cites to paragraph [0041] where Mani describes how “an audio query system coupled with the ASR may be employed to actively query the user for audio response input.” *Mani*, paragraph [0041]. Again, a user providing an audio response to a server or a computer application that interprets the data to verify that the user can access the network. There is no “voice connection” between the user and the server, as the server is simply a computer.

Therefore, Mani does not disclose the element of claim 1 of sending configuration data to a terminal on a first channel “*during a voice connection on said second channel.*”

Furthermore, Mani does not describe the server and first and second channels that are designed “...so as to make at least some of said services offered by said second network (RP) available to said terminal during said voice connection.” As stated in the Specification, “[t]he object of the invention is to enable mobile telephones 4 to access dynamically services offered by their own private network RP when they are connected to one of the public networks, for example the PLMN.” *Specification*, p. 9, lines 8-10. The Examiner cites to paragraph [0044] of

Mani as specifying that “further access interrogation, and thus a voice connection, may occur during the accessing of a service.” *Office Action*, p. 7. However, Mani does not specify that this “further access interrogation” occurs *during the accessing of a service*. In fact, Mani only states that “additional interrogation maybe carried out after a predetermined time has elapsed since gaining access.” *Mani*, paragraph [0044]. Read in the context of the entire paragraph, it is evident that this “additional interrogation” is the prompting of an additional request for user input in order to continue to access the network—a security feature to make sure that the user is still the one accessing the network. This would not take place at the same time that the user is accessing the network, as it would defeat the purpose of the interrogation if the user could continue to access the network while the “additional interrogation” was taking place. Instead, the “additional interrogation” procedure would need to halt access to the network and require user input before access could continue. Therefore, the additional interrogation of Mani is not the same as making services offered by a second network available to the terminal *during* a voice connection, as described in claim 1.

For at least the reasons stated above, the Applicant submits that Mani does not anticipate each and every the element of claim 1, as required for a rejection under 35 USC 102(e). The Applicant therefore requests that the rejection of claim 1 be withdrawn.

b. Claims 2-11

The Applicant refers the Examiner to the arguments presented above with regard to claim 1, and submits that claims 2-11 are allowable at least based on their dependency to claim 1.

c. Claim 12

The Applicant refers the Examiner to the arguments presented above with regard to claim 1, and submits that claim 12 is allowable for at least the same reasons.

d. Claims 13-22

The Applicant refers the Examiner to the arguments presented above with regard to claim 12 and therefore claim 1, and submits that claims 13-22 are allowable at least based on their dependency to claim 12.

IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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